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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,195	03/29/2001	Timothy C. Loose	47079-00086	4522

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JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/821,195	LOOSE ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

In reply to the amendment filed December 16th, 2004.

This action is final

Claims 1-10 are pending.

♦

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-3,** and **5-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Bruzzese (EP 0789338).

Regarding claims **1, 2, 7**, and **9,** Saffari teaches an electronic video wager system incorporating a video portion with reel game (Figure 3 & Col 1:33-55) and a non-video-portion (522, 523, & Col 3:2-5). The video portion further contains an integrated touch screen display and player selectable indicia (Col 2:64-3:2) as well as permanent second indicia (522). Saffari however is silent regarding the implementation of the permanent indicia as player selectable indicia and the incorporation of a unitary touch screen across both the video and non-video portions of the display.

In a related application however Bruzzese teaches the incorporation of a unitary touch screen (34) including permanent player selectable indicia (Figures 3-4 & Col 3:9-39). Wherein the unitary touch screen spans across both the immediately adjacent game outcome display (44) and non-game outcome portions of the display ("PLAY 1"). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the touch screen configuration of Bruzzese as taught above into the video game machine with touch screen of Saffari in order to reduce the device manufacture cost as taught by Bruzzese (Col 2:18-24).

Regarding claims **3, 5** and **6**, the elements (522) of Saffari may be considered to show the claimed permanent indicia. Alternatively however, Bruzzese teaches the use of an adhesive graphic transfer to create a graphic display or artwork panel as so claimed. Bruzzese further teaches the use of indicia including a "collect" indicia, to indication to the player touch points and their respective function of the artwork panel (Col 3:18-33 & Fig 3).

Regarding claim **8**, Saffari teaches the alteration of the video based indicia based on the progress or state of the game as so claimed (Figure 3).

Claim **4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Bruzzese (EP 0789338) as applied to claims 1 and 3 above in further view of Bridgeman et al (US 5,033,744).

The invention of Saffari/Bruzzese is silent regarding the selective illumination of indicia through lights located behind the artwork panel in order to indicate which indicia are active and may be selected by the player. However in a related application Bridgeman teaches the use of illuminated mechanical switches in order to indicate to a player that a video gaming machine is ready to accept user input (Figure 2 & Col 5:68-6:2). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the use of illumination to indicate the availability of a switch to accept inputs as taught by Bridgeman into the portion of a touch screen located over artwork as taught by Saffari/Bruzzese in order to direct the user to game inputs only when said inputs are available.

Claim **10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari et al (US 5,769,716) in view of Bruzzese (EP 0789338) as applied to claims 1 and 3 above in further view of Schneider et al (US 6,089,976).

The invention of Saffari/Bruzzese is silent regarding the displaying of a bonus outcome in response to a bonus outcome being achieved however Schneider teaches

the displaying of a bonus game on a bonus outcome (Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate this feature of Schneider into the invention of Saffari/Bruzzese to provide greater interaction between the player and game as well as provide a player with anticipation of the second game during the operation of the first game as taught by Schneider (Col 2:24-33).

Response to Arguments

Applicant's arguments filed December 16th, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant's arguments question the existence of "a touch screen over the permanent buttons" in the prior art however such limitations are not present in the claims at this time (Page 4/6).

The applicant's presents "Bruzzese does not disclose permanent player-selectable indicia via the touch screen" (Page4/6). In response the applicant is directed to figures and 3-4 related disclosure cited and now expanded in the relevant rejections

above for the clarification of this correlation. The permanent buttons reliant on the touch screen of Bruzzese are clearly present in at least figure 4.

The applicant challenges the motivation to combine the Saffari and Bruzzese references however fails to address the motivation presented with previous and now maintained rejection (Page 4/6).

The applicant challenges the modification of Bruzzese to include a video display however no such modification has been presented.

The applicant challenges the use of Bruzzese on a video slot machine under the proposed destructive teaching of "Bruzzese states that it is technically difficult to put a touch screen controller on a video screen." (Page 5/6). This summation of Bruzzese however is inaccurate as the actual quote reads, " There are difficult technical problems associated with bonding a touch screen controllers to curved monitor screens..." (Bruzzese Col 1:30-33). Bruzzese continues on to briefly explain at least one method by which the process can be accomplished while the primary reference of Saffari furthers this teaching in the disclosed embodiment. Bruzzese further states that despite the employment of more technologically advanced components by video gaming machines there is still a "significant demand" among player for "older-style" machines (Col 1:37-40), and thereby presenting the realization that video type machine are indeed more popular among gaming patrons. In the absence of any further evidence to the contrary this issue is considered addressed.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With additional regards to the mounting of a touch screen over a non-planer surface (Bruzzese) the applicant must consider the fact that the mechanical wheels of Bruzzese provide a surface with substantially greater curvature then a typical outer surface of a video monitor and the utilization of face glass, or the transparent planner surface that rests in between the player and the physical wheels (Figure 3-4) would equally solve any issues regarding the curvature of the game display means and the associated use of a touch screen therewith.

Remaining arguments are addressed in the body of the rejections above and will not be repeated here.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

GB 2251112A teaches a gaming machine with incorporated touch screen

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571)272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

Chanda L. Harris

CHANDA L. HARRIS
PRIMARY EXAMINER